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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

ANDERSON, REBECCA L

ART UNIT

PAPER NUMBER

1626

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/553,731	Applicant(s) HUBSCHWERLEN ET AL.	
	Examiner REBECCA L. ANDERSON	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,9,10,12,14,15 and 17 is/are pending in the application.
- 4a) Of the above claim(s) 6 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,12,14 and 15 is/are rejected.
- 7) ☒ Claim(s) 1-5,9,10,12,14 and 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-6, 9, 10, 12, 14, 15 and 17 are currently pending in the instant application. Claims 1-5, 12, 14 and 15 are rejected. Claims 1-5, 9, 10, 12, 14 and 15 are objected.

Response to Amendment and Arguments

Applicant's amendment and arguments filed 10 August 2010 have been fully considered and entered into the instant application.

Applicants' amendment has overcome the 35 USC 102(b) rejection of claims 1-5, 12, 14 and 15 as being anticipated by US Patent No. 5,240,942 by amending claim 1 to include the limitations of claim 11 and cancelling claim 11.

In regards to the 35 USC 103(a) rejection, while applicants have cancelled claim 11, the rejection is now applied to amended claim 1 and its dependent claims 2-5, 12, 14 and 15.

Applicants argue that nothing in the '942 patent would suggest that the compounds of the '942 patent could be used as antibacterial compounds and therefore one of ordinary skill in the art, at the time of the invention, would have lacked the motivation to modify the single methylene linker taught by the '942 patent to arrive at the 2 or 3 chain length alkylene of the instant invention as there would have been no expectation of success in achieving the antibacterial properties of the instant compound. This argument is not persuasive as the instant claims are product claims and not claims to the method of use. Additionally, according to *In re Dillon*, 919 F.2d 688, 696, 16 USPQ.2d 1897, 1904 (Fed. Cir. 1990) (in banc), cert. denied, 111 S. Ct. 1682 (1991),

Art Unit: 1626

there is no requirement that the prior art must suggest that the claimed product will have the same or similar utility as that discovered by applicant in order to support a legal conclusion of obviousness. An obviousness rejection is proper under Dillon so long as the prior art suggests a reason or provides motivation to make the claimed invention, even where the reason or motivation is based on a different utility from that discovered by applicant. As the Dillon opinion notes, the applicant then has the burden and opportunity to present relevant evidence to overcome the rejection. Lastly, according to MPEP 2141:

Furthermore, prior art that is in a field of endeavor other than that of the applicant (as noted by the Court in KSR, “[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one”, 550 U.S. at ___, 82 USPQ2d at 1396 (emphasis added)), or solves a problem which is different from that which the applicant was trying to solve, may also be considered for the purposes of 35 U.S.C. 103. (The Court in KSR stated that “[t]he first error...in this case was...holding that courts and patent examiners should look only to the problem the patentee was trying to solve. The Court of Appeals failed to recognize that the problem motivating the patentee may be only one of many addressed by the patent’s subject matter...The second error [was]...that a person of ordinary skill attempting to solve a problem will be led only to those elements of prior art designed to solve the same problem.” 550 U.S. at ___, 82 USPQ2d at 1397. Federal Circuit case law prior to the Supreme Court’s decision in KSR is generally in accord with these statements by the KSR Court. See e.g., In re Dillon, 919 F.2d 688, 693, 16 USPQ2d 1897, 1902 (Fed. Cir. 1990) (en banc) (“[I]t is not necessary in order to establish a prima facie case of obviousness that both a structural similarity between a claimed and prior art compound (or a key component of a

composition) be shown and that there be a suggestion in or expectation from the prior art that the claimed compound or composition will have the same or a similar utility as one newly discovered by applicant");

Therefore, minus a showing of unobvious results, it would have been obvious to one of ordinary skill in the art when faced with the prior art of US Patent No. 5,240,942, to prepare compounds as in applicants' instant claims as to those skilled in chemical art, one homologue is not such an advance over adjacent member of series as requires invention because chemists knowing properties of one member of series would in general know what to expect in adjacent members. In re Henze, 85 USPQ 261 (1950). The instant claimed compounds would have been obvious because one skilled in the art would have been motivated to prepare homologs of the compounds taught in the reference with the expectation of obtaining compounds which could be for the treatment of stress, migraines, anxiety and depression.

The 35 USC 103(a) rejection is therefore applied to amended claim 1 (amended to include the limitation of original claim 11) and claims 2-5, 12, 14 and 15 which depend from amended claim 1.

As the claims are rejected under 35 USC 103(a), the objection to the claims is maintained as the claims still include subject matter drawn to other than the elected embodiment.

Maintained Claim Objections

Claims 1-5, 9, 10, 12, 14 and 15 are objected to as containing non-elected subject matter. Claims 1-5, 9, 10, 12, 14 and 15 presented drawn solely to the elected embodiment would overcome this objection.

Art Unit: 1626

New Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

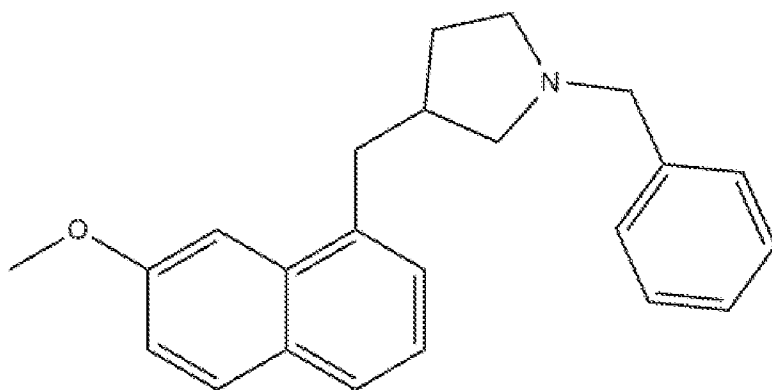
The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-5, 12, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,240,942.

US Patent No. 5,240,942 discloses the compound:



1-benzyl-3-[(7-methoxynaphth-1-yl)methyl]pyrrolidine

on columns 19 and 20,

example 29. This compound corresponds to applicants' instant invention wherein R1 is alkyloxy, specifically methoxy; X1-X5 are each CH; n is 0; Cy is a heterocycloalkylene group, specifically pyrrolidine; m is 0; and R3 is B-Y wherein B is an alkylene, specifically methylene and Y is an aryl, specifically phenyl. Pharmaceutical compositions are disclosed on column 27 and 8. The utility for the compound are found on column 8, for example, for the treatment of stress, migraines, anxiety, depression, etc.

The difference between the claimed invention and the compound of example 29 is the position equivalent to A. In the instant claims A-(CH₂)_n- has a chain length of 2 or 3 atoms, whereas in the prior art compound of example 29, A is an alkylene, specifically methylene.

However, minus a showing of unobvious results, it would have been obvious to one of ordinary skill in the art when faced with the prior art of US Patent No. 5,240,942,

Art Unit: 1626

to prepare compounds as in applicants' instant claims as to those skilled in chemical art, one homologue is not such an advance over adjacent member of series as requires invention because chemists knowing properties of one member of series would in general know what to expect in adjacent members. In re Henze, 85 USPQ 261 (1950). The instant claimed compounds would have been obvious because one skilled in the art would have been motivated to prepare homologs of the compounds taught in the reference with the expectation of obtaining compounds which could be for the treatment of stress, migraines, anxiety and depression. Therefore, the instant claimed compounds would have been suggested to one skilled in the art.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 1626

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (571) 272-0696. Mrs. Anderson can normally be reached Monday through Friday from 6:00am until 2:30pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*/Rebecca Anderson/
Primary Examiner, AU 1626*

Rebecca Anderson
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Art Unit 1626, Group 1620
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12 October 2010